



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/561,998 | 12/23/2005 | Erwin Kragt | PHUS030206 | 1342 |

24737 7590 03/16/2009
PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

| |
|----------|
| EXAMINER |
|----------|

KIM, STEVEN S

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3685

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

03/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/561,998 | Applicant(s) KRAGT ET AL. | |
| | Examiner STEVEN KIM | Art Unit 3685 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/23/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the US Application No. 10/561,998, filed on 12/23/2005.

Claims 1-20 are pending. Claims 1-20 have been examined.

Drawings

2. The drawings are objected to because the figures in the drawings are left blank. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

3. It is noted that the specification does not adhere to the standards described above, e.g. missing Background of the Invention, Brief Summary of the Invention.

4. It is noted that this application appears to claim subject matter disclosed in prior Application No. PCT/IB04/51038 and 60483774(US), filed 6/28/2004 and 6/30/2003 respectively. A reference to the prior application must be inserted as the first

Art Unit: 3685

sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111 (a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior

Art Unit: 3685

application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

5. If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

6. It is further noted that the claim does not adhere to the Office guideline, "the present Office practice is to insist that each claim must be the object of a sentence starting with 'I (or we) claim,' 'The invention claimed is' (or the equivalent)." See MPEP 608.01(m).

7. Claim 12 is noted with typographical error. ")" was used instead of "(".

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-7 and 9-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. In regards to claims 1-7 and 18-20, the claims are directed towards presentation of information, i.e. arrangement of content items, which do not fall under process, machine, manufacture, or composition of matter as required by 35 USC 101.

11. As per claim 9, the claim is directed towards software per se. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760.

12. As per claim 10, the claim is directed towards a signal per se. See MPEP 2106 IV B.

13. As per claims 11-17, based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-

Art Unit: 3685

88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity.

See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

14. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

15. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

16. In this particular case, claim 11-17 fails prong (1) because the “tie” (e.g. displaying) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

19. Per claims 1, 2, 3, 11, 12, 13, and 18, the claims recite icons “identifying a digital rights management system”. Icons are merely representation of data on a display and are non-functional descriptive material. Hence, it is unclear to one of ordinary skill in the art as to how a non-functional descriptive material is able to perform the steps of identifying.

20. The subsequent claims, 4-10, 14-17, 19, and 20, are rejected similarly as each depends on the claims 1, 2, 3, 11, 12, 13, and/or 18.

21. Further respect to claims 2-6, claim 1 recites “one or more icons ... **at least one of** identifying ... indicating accessibility... indicating rights”. However, claims 2-6 require only one possible combinations recited in claim 1. For example, if claim 1 is read with only “one or more icons identifying ...” then claim 2 is indefinite since claim 2 recites identifying, indicating accessibility, and indicating rights.

22. Similarly, in respect to claims 12-16, claim 11 recites “one or more icons ... **at least one of** identifying ... indicating accessibility... indicating rights”. However, claims 12-16 require only one of possible combinations recited in claim 11.

Art Unit: 3685

23. Claim 11 recites the limitation "the list". There is insufficient antecedent basis for this limitation in the claim.

24. In further regards to claims 1-20, the claims incorporate drawing(s) by reference. While the incorporation of reference to a specific figure is permitted, the incorporation "is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim. Incorporation by reference is a necessity doctrine, **not for applicant's convenience.**" Ex parte Fressola, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993); MPEP 2173.05(s). Furthermore, the figures/drawings are left blank.

25. Per claims 8-10, the claims are dependent on claim 1 that claims display arrangement, e.g. display (200). However, the claims are directed towards a system, a software program product, and a signal respectively. It is unclear to one of ordinary skill whether the claims are directed towards display (200) or a system/a software program product/a signal. It has been held a single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention (Ex Parte Lyell, 17 LISPQ2d 1548 (B.P.A.I. 1990)).

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,892,900, hereinafter referred to as Ginter.

28. In regards to claims 1, 8-10, 11, and 18, Ginter discloses a method and user interface comprising: displaying a set of display items each representing one of a plurality of protected content items (see Fig. 72D; col. 264, lines 28-42) including at least one content item protected by a first digital rights management system and at least an other one content item protected by a second digital rights management system (see col. 4, lines 61-64; col. 7, lines 4-7; col. 156 line 61 – col. 157 line 12); and displaying one or more icons in association with a display item for each protected content item within the list (see Fig. 72D; col. 264, lines 28-42).

29. While Ginter teaches indicating attributes related to content and user (see Fig. 72D), Ginter does not specifically disclose wherein the one or more icons at least one of identifying a digital rights management system protecting the respective protected content item, indicating accessibility to a user of a digital rights management access module for accessing the respective protected content item, and indicating rights of the user to access the respective protected content item. However, one or more icons

Art Unit: 3685

is/are merely non-functional descriptive material(s) that do not differentiate/effect the steps of displaying.

30. Moreover, Ginter teaches digital rights management using secure containers (see col. 1, lines 21-30; col. 4, lines 14-18; col. 13, lines 50-67). Furthermore, Ginter discloses displaying attributes related to content in relation to the user (see Fig. 72D). Therefore, a predictable result of Ginter would have been to display any other attributes related to contents, i.e. application extension or necessary application.

31. Furthermore, Ginter discloses a display on which the set of display items and the one or more icons are displayed (see Fig. 72D); a control producing display of the set of display items and the one or more icons on the display (see Fig. 72D; col. 264, lines 28-42; col. 9, lines 19-32); one or more user input mechanisms enabling a user to select either a display item within the set of display items or one of the one or more icons (see col. 61, lines 3-5).

32. As per claims 2-6, 12-16, and 19, the claims are directed towards descriptions of one or more icons. See above analysis.

33. Moreover, the appearance(s) of icons are merely design. [A design that] is a mere matter of choice in ornamentality and produces no new mechanical effect or advantage does not constitute invention and "Counsel for appellant also present arguments relating to the proportioning and tightness of fit of appellant's devices. Those matters are considered to involve mechanical skill only and to produce no such new or

Art Unit: 3685

unexpected result as would justify the allowance of the appealed claims." In re Seid, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947)

34. As per claims 7, 17, and 20, Ginter discloses wherein at least some of the one or more icons further comprise user control (a) enabling selective linking to or display of information regarding either acquisition of the digital rights management access module for accessing the respective protected content item or acquisition of rights to access the respective protected content item (see Fig. 72D, links; col. 264, lines 28-42).

Conclusion

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 5,041,992 discloses graphical elements specifically overlaying of graphical elements; US Patent Application No. 2002/0013826 discloses electronic content transaction; US Patent No. 6,384,849 discloses displaying controls using GUI; US Patent Application No. 2004/0117442 discloses file format including rights, Title, DRM and other content attributes.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

Art Unit: 3685

37. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

38. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./

Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685